

ESTTA Tracking number: **ESTTA535261**

Filing date: **04/30/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Alza Corporation
Granted to Date of previous extension	05/01/2013
Address	700 Eubanks Drive Vacaville, CA 95688 UNITED STATES

Attorney information	Masahiro Noda Drinker Biddle & Reath LLP 1177 Avenue of the Americas New York, NY 10036 UNITED STATES tmltdocket@db.com, masa.noda@db.com, melissa.berger@db.com, TMUS@its.jnj.com Phone:212-248-3140
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Applicant Information

Application No	85686365	Publication date	01/01/2013
Opposition Filing Date	04/30/2013	Opposition Period Ends	05/01/2013
Applicant	LABORATORIOS SALVAT, S.A. c/Gall 30-36 Esplugues de Llobregat, 08050 SPAIN		

Goods/Services Affected by Opposition

Class 005. All goods and services in the class are opposed, namely: Pharmaceutical and veterinary preparations for the treatment of ear or eye infections or inflammation of the ear or eye; antibiotics for otorhinolaryngological agent or for ophthalmological agent
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Mark Cited by Opposer as Basis for Opposition

U.S. Registration No.	1744235	Application Date	11/21/1991
Registration Date	01/05/1993	Foreign Priority Date	NONE
Word Mark	DOXIL		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 005. First use: First Use: 1991/11/01 First Use In Commerce: 1991/11/01 pharmaceutical products and formulations for the treatment of cancer

Attachments	DUOXAL opposition with Exhibit A.pdf (10 pages)(275383 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/MASAHIRO NODA/
Name	Masahiro Noda
Date	04/30/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

IN THE MATTER OF APPLICATION

Mark: DUOXAL
Applicant: Laboratorios Salvat, S.A.
Ser. No.: 85/686,365
Filed: July 25, 2012
Published in
the **Official Gazette**: January 1, 2013

ALZA CORPORATION,

Opposer,

v.

LABORATORIOS SALVAT, S.A.

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

ALZA CORPORATION, a Delaware corporation, having a principal place of business at 700 Eubanks Drive, Vacaville, CA 95688 (hereinafter “Opposer”), believes that it will be damaged by the registration of intent-to-use application Serial No. 85/686,365 for the mark DUOXAL filed by Laboratorios Salvat, S.A. (hereinafter “Applicant”), and having been previously granted extensions of time to oppose, hereby opposes the same.

As grounds for opposition, Opposer alleges the following:

1. Opposer ALZA Corporation is a pharmaceutical and medical systems company founded in 1968 and a member of the Johnson & Johnson Family of Companies, currently serving as one of Johnson & Johnson’s West Coast Pharmaceutical Research & Development sites. With a 40-year history of scientific innovation, Opposer’s drug delivery technology has been incorporated in 30 commercialized products sold worldwide.

2. Since 1991, Opposer has continuously used the mark DOXIL in commerce to identify pharmaceutical products.

3. Opposer owns U.S. federal Trademark Reg. No. 1,744,235 for the mark DOXIL, covering “pharmaceutical products and formulations for the treatment of cancer” in Class 5. Said mark was registered on January 5, 1993 with a claim of first use in commerce since at least as early as November 1991, and is valid, subsisting, and incontestable pursuant to 15 U.S.C. § 1065 (“Opposer’s Mark”). Copies of the TSDR status report and registration certificate for Opposer’s Mark are attached hereto as **Exhibit A**.

4. Upon information and belief, Laboratorios Salvat, S.A. is a sociedad anonima (sa), having a place of business at c/Gall 30-36, Esplugues de Llobregat 08050, Spain.

5. On information and belief, more than twenty (20) years after Opposer commenced use of Opposer’s Mark, on or about July 25, 2012, Applicant filed Application Serial No. 85/686,365 for the mark DUOXAL covering “pharmaceutical and veterinary preparations for the treatment of ear or eye infections or inflammation of the ear or eye; antibiotics for otorhinolaryngological agent or for ophthalmological agent” in Class 5 on an intent-to-use basis (“Applicant’s Mark”).

6. Upon information and belief, Applicant has not commenced use of Applicant’s Mark in U.S. commerce.

7. Opposer has priority over Applicant because Opposer’s use and registration dates precede the filing date for Applicant’s Application.

8. During the time that Opposer has used Opposer’s Mark, it has expended substantially large sums of money to advertise and promote its pharmaceutical products under such mark. As a result of extensive advertising and promotion, Opposer’s products sold and

advertised under Opposer's Mark have acquired public and consumer recognition throughout the United States, enjoy valuable goodwill, and are now assets of considerable value to Opposer.

9. By virtue of Opposer's long, extensive and widespread use and extensive sales and promotion, consumers have become accustomed to associate Opposer's Mark exclusively with Opposer.

10. Applicant's Mark so resembles Opposer's Mark as to be likely, when used in association with the goods covered by the subject application, to cause confusion or to cause mistake, or to deceive, with consequent injury to Opposer and the public.

11. Consequently, and without limitation, the marketing and sale of Applicant's aforementioned goods under Applicant's Mark is likely to cause consumers to believe that Applicant's goods are those of Opposer, that Applicant's goods are connected with the products of Opposer, and/or that Applicant is somehow related to or sponsored by Opposer. Accordingly, Applicant's Mark is not entitled to registration pursuant to 15 U.S.C. §1052(d).

12. Opposer will be damaged by the issuance and registration sought by Applicant within the meaning of 15 U.S.C. §1063 because such registration would support and assist Applicant in the confusing, misleading, and deceptive use of Applicant's Mark, and would give color of exclusive statutory rights to Applicant in violation and derogation of the prior and superior rights of Opposer.

WHEREFORE, Opposer prays that this opposition be sustained, that registration of Applicant's Mark be denied, and that the Board grant such other relief as may be just and proper.

Respectfully submitted,

DRINKER BIDDLE & REATH LLP



Dated: April 30, 2013

By:

Masahiro Noda
Melissa Berger
1177 Avenue of the Americas
New York, NY 10036
Tel: (212) 248-3140
Fax: (202) 202-4033

*Attorneys for Opposer
Alza Corporation*

CERTIFICATE OF SERVICE

I hereby certify that a copy of the foregoing Notice of Opposition was served on counsel of record for Applicant at the following address of record by first class mail, postage prepaid, this 30th day of April 2013:

MICHAEL J. STRIKER
STRIKER, STRIKER & STENBY
103 E NECK RD
HUNTINGTON, NEW YORK 11743-1567



Melissa Berger

EXHIBIT A

Int. Cl.: 5

Prior U.S. Cl.: 18

United States Patent and Trademark Office **Reg. No. 1,744,235**
Registered Jan. 5, 1993

**TRADEMARK
PRINCIPAL REGISTER**

DOXIL

LIPOSOME TECHNOLOGY, INC. (DELAWARE
CORPORATION), DBA LTI
1050 HAMILTON COURT
MENLO PARK, CA 94025

FIRST USE 11-1-1991; IN COMMERCE
11-1-1991.

FOR: PHARMACEUTICAL PRODUCTS AND
FORMULATIONS FOR THE TREATMENT OF
CANCER, IN CLASS 5 (U.S. CL. 18).

SER. NO. 74-223,789, FILED 11-21-1991.

TOMAS V. VLCEK, EXAMINING ATTORNEY

USPTO will deploy a small maintenance release for Trademark Status and Document Retrieval (TSDR) system. Deployment will start at 10:00 p.m. on Friday, April 26 and end at 5:00 a.m. on Saturday, April 27. TSDR will be unavailable during the deployment period.

STATUS DOCUMENTS[Back to Search](#)[Print](#)

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Mark: DOXIL

DOXIL

US Serial Number: 74223789

Application Filing Date: Nov. 21, 1991

US Registration Number: 1744235

Registration Date: Jan. 05, 1993

Register: Principal

Mark Type: Trademark

Status: The registration has been renewed.

Status Date: Nov. 13, 2012

Publication Date: Oct. 13, 1992

Mark Information

Mark Literal Elements: DOXIL

Standard Character Claim: No

Mark Drawing Type: 1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)

Goods and Services**Note:**

The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;

- Double parenthesis ((.)) identify any goods/services not claimed in a Section 15 affidavit of
- Asterisks *. * identify additional (new) wording in the goods/services.

For: pharmaceutical products and formulations for the treatment of cancer

International Class(es): 005 - Primary Class

U.S Class(es): 018

Class Status: ACTIVE

Basis: 1(a)

First Use: Nov. 01, 1991

Use in Commerce: Nov. 01, 1991

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name: ALZA CORPORATION

Owner Address: 700 Eubanks Drive
Vacaville, CALIFORNIA 95688
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where
Organized: DELAWARE

Attorney/Correspondence Information

Prosecution History

Maintenance Filings or Post Registration Information

TM Staff and Location Information

Assignment Abstract Of Title Information - Click to Load

Proceedings - Click to Load